

### **REMARKS**

Applicant hereby adds new claims 125-132. Accordingly, claims 89-132 are pending in the present application.

Claims 89-107 and 115-124 stand rejected under 35 U.S.C. 112, second paragraph. Claims 89-124 stand rejected under 35 U.S.C. 112, first paragraph. Claims 89-91, 93-96, 98-102, 104-106, 108-113, 115-117, and 119-123 stand rejected under 35 U.S.C. 102(b) for anticipation by U.S. Patent No. 5,670,066 to Barnes et al.

Applicant respectfully traverses the rejections and urges allowance of the present application.

Referring to independent claim 89, the Office Action on pages 3-4 identifies teachings which allegedly disclose or suggest limitations of such claim. It is stated that electrodes 34, 38 are considered as circuitry of the workpiece holder and wafer 32 would *inherently* have circuitry at its bottom. In support of the anticipation rejection of claim 89, the Office Action also alleges that wafer 32 is electrically coupled to the electrodes 34, 38 of holder 30 and circuitry of the wafer communicates with circuitry 34, 38 of holder 30. The Examiner is mistaken.

Referring to cols. 3-4 of Barnes, chuck 30 is activated to **hold workpiece 32 in place** by selectively applying a DC voltage between electrodes 34, 38. The DC voltage is sufficient to produce an electrostatic force to clamp workpiece 32 in situ between electrodes 34, 38. It is further taught that clamping forces are applied to workpiece 32 only after a determination has been made that the workpiece is properly in place.

The provision of electrostatic force by electrodes 34, 38 of chuck 30 or other teachings of Barnes fail to disclose or suggest the claimed *coupling circuitry of the wafer with circuitry of the workpiece holder* as recited in claim 89. The Examiner's reliance upon inherency in support of the allegation that wafer 32 has circuitry at its bottom is misplaced.

The Examiner is reminded that, "in relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Barnes discloses chuck 30 establishing an electrostatic force to hold wafer 32 in place. The mere utilization of an electrostatic clamping force provides absolutely no teaching or suggestion of the wafer having circuitry at its bottom nor coupling circuitry of the wafer with circuitry of the workpiece holder as claimed. The provision of the clamping force is applied regardless of the configuration of the wafer including circuitry or not including circuitry. Accordingly, the application and generation of the clamping force is independent of wafer 32 having or not having circuitry. The allegedly inherent characteristics (i.e., the wafer having circuitry at its bottom) do not necessarily flow from the teachings of Barnes and claim 89 is allowable for at least this reason.

Further, the application of the electrostatic force of Barnes fails to disclose or suggest any communication of signals intermediate wafer 32 and chuck 30. Assuming arguendo, even if Barnes were considered to disclose "circuitry at its bottom" as alleged, there is no *communication of signals intermediate the circuitry of the wafer and the*

**circuitry of the workpiec holder** as claimed. Applicant notes the Office Action is devoid of identifying any teachings of Barnes which allegedly disclose or suggest the claimed communicating. The electrostatic clamping force fails to teach or suggest the claimed communicating. Numerous positively-recited limitations of claim 89 are not shown nor suggested by the art and claim 89 is allowable for this additional reason.

In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicant respectfully requests identification ***in a non-final action*** of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R. §1.104(c)(2). In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicant, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicant respectfully requests clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a **non-final Action** if any claims are not found to be allowable.

The claims which depend from independent claim 89 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, claim 90 recites coupling circuitry of the wafer and the circuitry if the workpiece holder at a surface of the wafer. There is no teaching or suggestion in Barnes of coupling at a surface of the wafer as claimed. The Examiner alleges that it appears that Barnes teaches limitations of claim 90. The Examiner is mistaken. Barnes teaches application of an electrostatic clamping force. Barnes is silent regarding teaching or suggesting any circuitry of the wafer and the clamping force is applied regardless of the configuration of the workpiece 32. The prior art fails to disclose or suggest limitations of claim 90 and claim 90 is allowable for at least this reason. The Office Action makes conclusory statements with absolutely no reliance upon teachings in the prior art. In compliance with the C.F.R., Applicant respectfully requests issuance of a non-final Action if claim 90 is not allowed and which properly identifies teachings of the art which allegedly disclose or suggest the claimed limitations. Referring to claim 94, page 3 of the Office Action states electrode 38 is considered circuitry of the workpiece holder. On page 4 of the Action, it is stated that it appears that the electrode 38 corresponds the claimed intermediate member. The singular electrode 38 fails to teach or suggest both of Applicant's claimed circuitry of the workpiece holder and the claimed intermediate member. Clarification of any rejection of claim 94 over the prior art is requested in a non-final Action if claim 94 is not allowed.

Referring to claim 95, the Office Action fails to identify any teachings of Barnes allegedly disclosing or suggesting the claimed contacting of circuitry of the wafer with circuitry of the workpiece holder as claimed. Barnes is devoid of disclosing or suggesting

any circuitry of a wafer let alone the contacting limitation of claim 95. Claim 95 is allowable for at least this reason. Clarification of any rejection of claim 95 over the prior art is requested in a **non-final Action** if claim 95 is not allowed.

Referring to claim 96, Barnes is devoid of teaching or suggesting any communication of signals let alone *communication of signals comprising **information*** as claimed. A clamping force fails to teach or suggest signals comprising information as claimed. Limitations of claim 96 are not taught nor suggested by the art and claim 96 is allowable. Clarification of any rejection of claim 96 over the prior art is requested in a **non-final Action** if claim 96 is not allowed.

Referring to claim 97, Barnes is devoid of any disclosure or suggestion of *communicating signals comprising **information regarding the process conditions*** as claimed. The Office Action fails to identify any teachings which allegedly disclose limitations of claim 97. Claim 97 is allowable and clarification of any rejection of claim 97 over the prior art is requested in a **non-final Action** if claim 97 is not allowed.

Independent claim 98 recites ***communicating signals** intermediate the second workpiece and the workpiece processing apparatus*. Barnes merely discloses using an electrostatic clamping force to clamp a workpiece onto a chuck. The clamping fails to teach or suggest the communication of signals intermediate the second workpiece and the apparatus as claimed. Claim 98 is allowable for at least this reason. Clarification of any rejection of claim 98 over the prior art is requested in a **non-final Action** if claim 98 is not allowed.

The claims which depend from independent claim 98 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Independent claim 108 recites coupling circuitry of the wafer with circuitry of the workpiece holder and communicating signals intermediate the circuitry of the wafer and the circuitry of the workpiece holder. The Examiner fails to identify any teachings of Barnes which allegedly disclose coupling **circuitry of the wafer** or communicating signals intermediate the **circuitry of the wafer** and circuitry of the workpiece holder. Any reliance upon inherency is misplaced and the electrostatic clamping force teachings fail to disclose or suggest the claimed coupling circuitry of the wafer or the claimed communicating of signals. Limitations of claim 108 are not shown nor suggested by the art and claim 108 is allowable. Clarification of any rejection of claim 108 over the prior art is requested in a **non-final Action** if claim 108 is not allowed.

The claims which depend from independent claim 108 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to independent claim 115, Barnes fails to disclose or suggest **communication of signals using a workpiece** provided within a workpiece processing apparatus as claimed. The clamping electrostatic force generated by the chuck of Barnes fails to disclose or suggest the claimed communicating. Claim 115 is allowable for at least

this reason. The clamping force of Barnes also fails to disclose or suggest the receiving of signals within the apparatus from the workpiece. Numerous limitations of claim 115 are not shown nor suggested by the prior art and claim 115 is allowable for at least this reason. Clarification of any rejection of claim 115 over the prior art is requested in a non-final Action if claim 115 is not allowed.

The claims which depend from independent claim 115 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Barnes is devoid of disclosing numerous limitations of Applicant's claims at least some of which have been identified above. The only source of the rejections may result from the personal knowledge of the Examiner. Applicant hereby requests identification of prior art which discloses claimed limitations not found in the references of record or the submission of an affidavit in support of any rejection of the claims in a non-final Action. "[A]ssertions of technical facts in areas of esoteric technology must always be supported by citation of some reference work" and "allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported." *In re Ahlert*, 424 F.2d 1088, 165 USPQ 418, 420-421 (CCPA 1970).

With respect to the indefiniteness rejections, Applicant submits the claims 89-107 and 115-124 are definite and understood by one of ordinary skill in the art. Initially, Applicant notes that independent claims 89, 98 and 115 have been examined no less than three times by the Examiner. Further, a previous indefiniteness rejection made against the

first two independent claims has already been withdrawn by the same Examiner during earlier prosecution of this application. Nonetheless, in view of the following, and the express teachings of the originally filed specification, the pending claims are definite.

With respect to claim 89, 98 and 115 the Examiner states it is unclear how the semiconductor device is interrelated and associated with the circuitry of the wafer and the circuitry of the workpiece holder and it is unclear how the semiconductor device is interrelated and associated with the communicating step. In response, Applicant submits the semiconductor device is not expressly related or associated with the circuitry of the wafer or circuitry of the workpiece holder in the identified claims. Further, the semiconductor device is not expressly related or associated with the communicating step. Applicant submits the absence of such relationship or association is irrelevant to the definiteness or indefiniteness of the claims.

35 U.S.C. §112, second paragraph, requires that the claims particularly point out and distinctly claim the subject matter that *the patent applicant regards as their invention*. "Distinctly" has been interpreted to mean simply that the claim must have a clear and definite meaning when construed in the light of the complete patent document. *Standard Oil Company v. American Cyanamid Company*, 774 F.2d 448, 227 USPQ 293 (Fed. Cir. 1985). Further, the definiteness of the claim language employed must not be analyzed in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one of having ordinary skill in the pertinent art. Applicant submits such language is clearly understandable by one of skill in



the art, and definite in light of and well supported by the originally filed specification. One skilled in the art would have no problem understanding the pending claims. Such claims are certainly definite when the specification and claims are read as a whole.

Applicant notes the requirements of MPEP '2173.04 and breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if Applicant has not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph. Applicant requests withdrawal of the indefiniteness rejections.

With respect to the rejection under 112, first paragraph, Applicant has amended the claims where appropriate to positively recite subject matter already inherent in such amended claims. Support for the amendments may be found at least in the original teachings of Figs. 1-3, 6 and 8 and related specification teachings including at least pages 6-12 and 16-20.

Applicant adds new claims 125-132 which are supported at least by Figs. 1-3, 6, and 8 and the specification.

Applicant submits a copy of a form PTO-1449 which has not been initialed. Applicant requests initialization of the form and return of the form to Applicant.


Applicant requests allowance of all pending claims.

Serial No. 09/827,248  
Amdt. Dated 12/15/2003  
Office Action dated 08/13/2003

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Dated: 12/15/03

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